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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,813	04/20/2001	Mark R. Squeglia	20-EB-5010/624226.313	2810

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EXAMINER

HAQ, NAEEM U

ART UNIT PAPER NUMBER

3625

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/838,813

Applicant(s)

SQUEGLIA ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.8
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim recites the limitation "the respective links" in line 1. There is insufficient antecedent basis for this limitation in the claim. For examination purposes, the Examiner will assume that claim 4 is dependent on claim 3 since claim 3 recites a "respective link" limitation whereas claim 2 does not. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolls (US 6,389,337 B1).**

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Referring to claims 1 and 14, Kolls a computerized method and system for managing supply of replacement parts used for servicing a piece of equipment, said method and system comprising: providing a database of parts supply data indicative of availability of replacement parts (column 25, lines 3-10; column 49, lines 26-29); providing an input/output device at a service site in communication with the database (column 5, line 35 – column 8, line 67; column 25, lines 3-15); transmitting from the service site to said database a computer-readable order, wherein said order is configured to identify respective parts and quantity thereof to be made available for said service site (column 24, lines 35-58; column 49, lines 20-32; column 50, lines 32-38); processing said order relative to the data stored in the database to determine availability of the parts identified in the order (column 49, lines 26-29; column 50, lines 48-61; column 55, lines 57-65); gathering replacement parts for the service site (column 49, lines 29-32); and updating said database to log transactions that occur in connection with said replacement parts for the service site (column 36, lines 18-23; column 45, line 66 – column 46, line 6; column 49, lines 5-19).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (US 6,389,337 B1) in view of Official Notice.**

Referring to claim 2, Knolls teaches transmitting an order confirmation message to the service site (column 50, lines 57-61; column 57, lines 4-10). Kolls does not teach that the confirmation message contains availability and delivery date information. However, Official Notice is taken that it is old and well known in the art to communicate availability and delivery date information for a product. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the method and system of the prior art. One of ordinary skill in the art would have been motivated to do so in order to allow the service center to plan its service schedule based on the availability and delivery date of the part.

**Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (US 6,389,337 B1).**

Kolls does not teach that the order includes a part identifier selected from the group comprising part name, part number, part description and visual representation thereof. However, the Examiner notes that this limitation is not functionally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of the method would be performed the same regardless of what information the order contained. The difference between the Applicants' order and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir.

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1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the order of Kolls because such information does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

**Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (US 6,389,337 B1) in view of Ross, Jr. et al. (US 6,629,135 B1).**

Referring to claim 3, Kolls does not teach transmitting a message to the service site indicative of part unavailability when the order identifies parts not presently available, wherein said message includes respective links indicative of options regarding an unavailable part. However, Ross teaches this limitation (column 7, lines 30-43). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Ross into the method and system of Kolls. One of ordinary skill in the art would have been motivated to do so in order to notify the user that the selected product was unavailable, as taught by Ross.

Referring to claim 4, Kolls does not teach that the respective link indicates substitute part for the unavailable part. However, Ross teaches this limitation (column 7, lines 30-43). Ross teaches that if coffee pot A is unavailable then the user is provided a link to other coffee pots. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature

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into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide the user with other suitable products, as taught by Ross.

**Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (US 6,389,337 B1) in view of Ross, Jr. et al. (US 6,629,135 B1) and further in view of Official Notice.**

The cited prior art does not teach that the respective links indicate alternative suppliers for an unavailable part. However, Official Notice is taken that it is old and well known in the art for a link to indicate a supplier. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to create an affiliate system among a plurality of suppliers.

**Claims 6-8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (US 6,389,337 B1) in view of Moskowitz et al. (US 2002/0198788 A1).**

Referring to claims 6-8 and 15, Kolls does not teach scanning a code associated with a part being ordered, or providing a Web page upon scanning the code associated with the part being ordered and wherein the data field includes a part (product) sale. However, Moskowitz teaches a system and method of providing a web page with a product sale data field when a product code is scanned (Figure 8, page 4, paragraphs [0045]-[0047]; Figure 5). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Moskowitz into the cited prior art. One of ordinary skill in the art would have been motivated to do

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so in order to encourage users to register or provide product evaluation for the purchased product, as taught by Moskowitz.

**Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (US 6,389,337 B1) in view of Showghi et al. (US 2003/0050854 A1).**

Kolls does not teach that the order further includes an account identifier and wherein upon fulfillment of that order, costs associated with that order are charged against that account. However, Showghi teaches this limitation (page 7, paragraphs [0083] and [0084]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to automate the payment once the order has been fulfilled, as taught by Showghi.

**Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (US 6,389,337 B1) in view of Attia (US 2002/0016750 A1).**

Referring to claim 13, Kolls does not teach that in the event a part is no longer manufactured, transmitting a message to the service site suggesting a superseding replacement kit for servicing a respective assembly. However, Attia teaches this limitation (page 8, paragraph [0104]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to notify a user that the select product does not exist, as taught by Attia.



***Conclusion***

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

June 27, 2004



Jeffrey A. Smith  
Primary Examiner